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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,402	11/28/2001	Samir Narendra Mehta	320037.402	2381

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EXAMINER
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DOAN, DUYEN MY

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/997,402

Applicant(s)

MEHTA ET AL.

Examiner

Duyen M. Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/17/2002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **Detail Action**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. Claims 30-44 are not limited to tangible embodiments. In view of Applicant's claims 30-44, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., [memory, Ram, Rom...]) and intangible embodiments (e.g., transmission medium...). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the specification at the bottom, carrier medium and transmission media would be not statutory but storage media would be statutory.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-10, 12, 14-20, 22-23, 24-26, 29 are rejected under 102 (e) being unpatentable over Weinman, Jr. (us pat 6658455) (hereinafter Weinman).

As regarding claim 1, Weinman disclosed provisioning the content for the target device (col.15, lines 25-67); verifying that the device supports execution of the content by comparing the device capabilities to the content requirements (col.15, lines 25-67); and providing the verified and provisioned content (col.15, lines 25-67).

As regarding claim 2, Weinman disclosed causing the prepare content to downloaded to the target device over a wireless transmission medium (col.15, lines 32-39).

As regarding claim 3, Weinman disclosed the content is requested by a subscriber of a carrier to the computer base environment over a wireless transmission medium (col.5, lines 32-39).

As regarding claim 4, Weinman disclosed at least one of inspecting the content; optimizing the content; and instrumenting the content (col.15, lines 45-67, col.16, lines 1-11).

As regarding claim 5, Weinman disclosed at least one of determining whether the content contains malicious code; determining whether the content contains banned code; and determining whether the content contains designated API (see col.45-67, col.16, lines 1-41).

As regarding claim 6, Weinman disclosed the API is at least one of packages, classes, methods, and fields (col.15, lines 63-67, col.16, lines 1-9).

As regarding claim 7, Weinman disclosed the inspecting is performed using an application filter (col.12, lines 4-49).

As regarding claim 8, Weinman disclosed the application filter specifies a list of criteria to be filtered and a target (col.12, lines 4-49).

As regarding claim 9, Weinman disclosed the criteria is an API (col.12, lines 4-49, software version).

As regarding claim 10, Weinman disclosed that target is at least one of a specified client, device type, content identifier, and global definition (col.12, lines 4-49).

As regarding claim 12, Weinman disclosed inserting code that implements at least one of a billing policy, a usage policy, a notification, and an automatic content updated mechanism (col.11, lines 12-60).

As regarding claim 14, Weinman disclosed the provisioning provides code to support billing policy (col.11, lines 12-60).

As regarding claim 15, Weinman disclosed at least one of subscription based billing, trial use, download based billing, transmission based billing, and prepaid billing (col.11, lines 12-60).

As regarding claim 16, Weinman disclosed the billing policies are provided by a wireless carrier infrastructure (col.11, lines 12-60).

As regarding claim 17, Weinman disclosed at least one of: comparing the API used by the content to the API supported by the target device; determining whether the requestor is authorized to use the content; and determining whether the content

is banned (col.2, lines 48-55, determine whether the requester is authorized to use the content).

As regarding claim 18, Weinman disclosed determining whether the requestor is authorized determines whether the requestor has sufficient funds in a prepaid billing account to use the content (col.6, lines 55-67, col.7, lines 1-42).

As regarding claim 19, Weinman disclosed the verification is accomplished using profile management (col.12, lines 4-49).

As regarding claim 20, Weinman disclosed the profile management defines profiles for at least one of a subscriber, device type, and content (col.12, lines 4-49).

As regarding claim 22, Weinman disclosed the environment is integrated with a wireless carrier infrastructure (col.5, lines 17-40).

As regarding claim 23, Weinman disclosed the content preparation provides walled-garden provisioning (see col.12, lines 4-49, col.15, lines 25-67).

As regarding claim 24, Weinman disclosed the computer-based environment including a network, wherein the provisioning supports the designation of the content to be prepared through browsing to a location on the network (col.6, lines 1-11).

As regarding claim 25, Weinman disclosed the network is the Internet (col.6, lines 4).

As regarding claim 26, Weinman disclosed the preparation process takes into account preferences of a requester of the content (col.12, lines 4-42, col.15, lines 25-67).

As regarding claim 29, Weinman disclosed the content contains at least one of text, graphic, audio, and video (col.4, lines 1-19).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weinman, Jr. (us pat 6658455) (hereinafter Wienman) in view of Galensky et al (us pat 6845398) (hereinafter Galensky).

As regarding claim 11, Weinman disclosed all limitations of claim 1 above, but Weinman did not expressly disclose at least one of: reducing the size of variable names; modifying instructions to more efficient instructions; and removing unused code.

Galensky taught at least one of: reducing the size of variable names; modifying instructions to more efficient instructions; and removing unused code (col.2, lines 21-24, col.3, lines 26-28).

It would have been obvious to one with ordinary skill in the art at time the invention was made to combine the teaching of Galensky with the method of Weinman to reducing the size of variable names for the purpose of to ensure high quality and minimal degradation of the original audio source, such digital audio files are typically encoded and compressed in file format (see, Galensky col.1, lines 25-27).

Claims 13 and 21, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinman, Jr. (us pat 6658455) (hereinafter Weinman) in view of Moles et al (us 2003/0162533) (hereinafter Moles).

As regarding claim 13, Weinman disclosed all limitation of claim 1 above, but Weinman did not expressly disclose the instrumenting is accomplished at a byte-code level of content examination.

Moles taught instrumenting is accomplished at a byte-code level of content examination (pg.2, paragraph 19, paragraph 24).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Moles to the method of Weinman to have instrumenting is accomplished at a byte-code level of content examination for the purpose of automate cellular service provisioning to the greatest extent possible in order to reduce labor costs, eliminate errors, and make the process more user-friendly by minimizing or eliminating subscriber interaction (see Moles pg.2, paragraph 17).

As regarding claim 21, Weinman disclosed all limitation of claim 1 above, but Weinman did not expressly disclose the content is Java-based.

Moles taught the content is Java-based (pg.6, paragraph 67).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Moles to the method of Weinman to have the content is Java-based, for the purpose of automate cellular service provisioning to the greatest extent possible in order to reduce labor costs, eliminate



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errors, and make the process more user-friendly by minimizing or eliminating subscriber interaction (see Moles pg.2, paragraph 17).

As regarding claim 27, Weinman disclosed all limitations of claim 1 above, but Weinman did not expressly disclose attributes that control the provisioning are specified through website administration.

Moles taught attributes that control the provisioning are specified through website administration (see figure 1, provisioning server).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Moles to the method of Weinman to have attribute that control the provisioning are specified through website administration, for the purpose of automate cellular service provisioning to the greatest extent possible in order to reduce labor costs, eliminate errors, and make the process more user-friendly by minimizing or eliminating subscriber interaction (see Moles pg.2, paragraph 17).

As regarding claim 28, Weinman disclosed all limitations of claim 1 above, but Weinman did not expressly disclose attributes that control the verification are specified through website administration.

Moles taught attributes that control the verification are specified through website administration (see Figure 1, provisioning server). The same motivation was utilized in claim 27 applied equally well to claim 28.

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As regarding claims 30-44, the limitations are similar to claims 1-29, therefore rejected for the same rationales as claims 1-29

As regarding claims 45-60, the limitations are similar to claims 1-29, therefore rejected for the same rationales as claims 1-29.

As regarding claims 61-73, the limitations are similar to claims 1-29, therefore rejected for the same rationales as claims 1-29.

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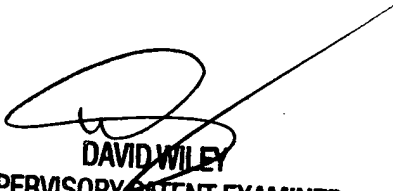
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner  
Duyen Doan  
Art unit 2143

DD



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